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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,686	07/23/2003	Takashi Fujikado	116402	6681
25944	7590	10/05/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			BOCKELMAN, MARK	
		ART UNIT		PAPER NUMBER
		3762		

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TWH

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/624,686	FUJIKADO ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Mark W. Bockelman	3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 September 2005.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 9-11 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 9-11 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 9-16-2005 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 9 now recites a step of connecting a cable from a receiver to a converter. Applicant's specification describes a receiver (antenna 24), a converter 26, electrode array 21a, return electrode 23c. The only cable described in applicant's specification is cable 23, which has two wires one of which (23a) extends from the electrode array to the converter 26, and a second of which (23b)

extends from the converter 26 to the return electrode. The written description for the electrical connection between the receiver 24 and the converter 26 is absent from the disclosure. It is unclear as to whether it is formed on the housing or merely extends away from the housing. Nevertheless, there is no description of a cable being connected between the converter and the receiver. In addition, the cable is only shown to extend out of the sclera, and not between the sclera and the choroid as was claimed in the amendment of 6-16-2005 and deleted in the examiner's amendment of 7-8-2005.

The examiner respectfully requests applicant to review their specification and particularly point out where they believe they have support for each claimed limitation when responding to the examiner's office action(s).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 now recites that the electrode array is adapted to be connected to a converter, which is merely and intended use of the array and not a positive recitation of the converter. Later in the claim, applicant recites a cable extending between the converter and the receiver. It is unclear whether the converter is positively recited in the claim or not.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow et al USPN 6,427,087 in view of Ok et al. USPAP 2002/0095193 and Tassicker USPN 2,760,483.

Chow et al show an implantable electrode array implanted under the retina so as to stimulate neurons responsible for sight. Column 4, first paragraph of Chow et al. teaches that the originating signals for retinal stimulation may originate outside the eye be and transmitted to a coil inside the eye. Applicant differs in reciting a converter, and a cable extending from the converter to a receiver, as well as the positioning of of the electrode array between the choroid and the sclera. Ok et al. teaches a device for performing the tasks suggest by Chow, namely an implanted coil receiver 18, a converter (60, 28) and a cable connecting the two for receiving signals from and external camera and converting the transmitted signal to an electrode signal for stimulating the electrode array. To have used the Ok et al. device for implementing the Chow et al method would have been obvious to those considering the collective teachings of the two patents. In addition, Tassicker further teaches that a stimulating electrode array for simulating sight can be positioned between the choroid and the retina, or alternatively the choroid and the sclera if the risk of damaging the retina during

separation is too great. Because, the light has to pass through another layer of tissue, it does not work as well, however, it still serves to stimulate the retina. To have positioned the electrode array of Chow between the choroid and the sclera for its surgical benefits as taught by Tassicker would have been obvious to one of ordinary skill in the art since neurons responsible for sight may still be stimulated without risking damage to the retina during separation.

***Response to Arguments***

Applicant's arguments filed 6-19-2005 have been fully considered but they are not persuasive. Applicant's argument that Tassicker teaches away from implanting the electrode array between the choroid and the sclera is not deemed persuasive since Tassicker does not teach away from such an invention but states that the alternative positioning, for his stimulator, may not be as effective. Teaching one method as a preference between alternatives is not considered a teaching away from the alternative, especially as in this case, when the reference is considered as a whole.

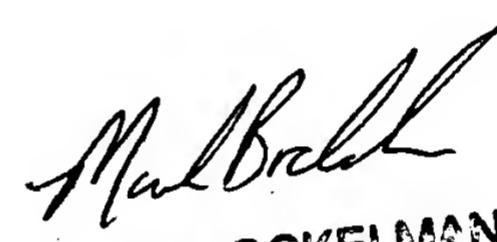
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark W. Bockelman whose telephone number is (571) 272-4941. The examiner can normally be reached on Monday - Friday 10:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272 -6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MWB

October 1, 2005



MARK BOCKELMAN  
PRIMARY EXAMINER